

Remarks

Applicant has amended claim 1. Claim 4 has been canceled as no longer appropriate in view of the amendment of claim 1. New claims 9 and 10 have been added. Claim 9 adds polyhydric alcohol to the preparation of claim 1. Claim 10 is equivalent to formerly pending claim 4 in that it specifies certain types of polyhydric alcohol. No new matter has been added.

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1, 3-5, 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over JP 57-206614 (hereinafter JP '614) in view of U.S. Patent No. JP 61-260014 (hereinafter JP '014). Applicant respectfully traverses the rejection.

In support of the rejection, the Examiner relies upon In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). The facts of the Kerkhoven case militate against a finding of obviousness of the instant claimed invention.

In Kerkhoven, the compositions of the combined prior art and the claimed invention were not simply useful for the same purpose, they were composed of the same ingredients. In Kerkhoven the court held that a process of preparing a spray-dried detergent by mixing together two prior art spray-dried detergents was *prima facie* obvious. In other words, the two prior art detergents (A, B) were combined to obtain the claimed detergent (C).

In contrast, in the instant case the compositions of the prior art, while allegedly useful for the same purpose (to give a cooling sensation), are not composed of the same ingredients. The Examiner acknowledged this fact on page 2 of the Office Action: "JP '614 does not teach a glycol or a polyhydric alcohol. However, JP '014 discloses a hydrous patch comprising an adhesive preparation containing a polyhydric alcohol..." Therefore, while the prior art compositions might be considered as being useful for the same purpose, the compositions are based on different formulations, and the combination of the prior art compositions does not provide Applicant's claimed invention (i.e., $A + B \neq C$).

There is no evidence presented by the Examiner suggesting that a single component (polyhydric alcohol) can be selected from the adhesive preparation of JP '014 for addition into the adhesive preparation of JP '614. In this regard, Applicant notes that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975); In re Geiger, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987) ("Based upon the prior art and the fact that each of the three components of the composition used in the claimed method is conventionally employed in the art for treating cooling water systems, the board held that it would have been prima facie obvious, within the meaning of 35 U.S.C. 103, to employ these components in combination for their known functions and to optimize the amount of each additive.... Appellant argues... hindsight reconstruction or at best,... 'obvious to try' We agree with appellant.").

Therefore, Applicant asserts that the Examiner has failed to meet the burden of providing the evidence necessary to establish a prima facie case of obviousness.

To facilitate allowance of the claims, and to further distinguish the claimed invention from the cited prior art, Applicant has amended claim 1 to remove the reference to polyhydric alcohol. New claim 9 adds polyhydric alcohol as an additional component of the claimed preparations. New claim 10 (equivalent to previously pending claim 4) further limits the polyhydric alcohol.

The claims as now amended thus provide an invention that the combination of the JP '614 and the JP '014 references simply does not describe. Both the JP '614 and the JP '014 references fail to disclose the glycol feature of claim 1 as amended (1 -50wt% of a glycol). In view of the amendment, it is clear that one of ordinary skill in the art would have no motivation

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to combine these two references, at least for the reason that neither provides for the presence of a glycol in the preparations.

Accordingly, in view of the amendments and remarks above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1, 3-5, 7 and 8 under 35 U.S.C. § 103 as obvious over JP '614 in view of JP '014.


CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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